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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,521	03/03/2000	YOSHIKI NAKAGAWA	1581/00180	2445

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 08/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/446,521

Applicant(s)

NAKAGAWA ET AL.

Examiner

Jeffrey C. Mullis

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): ____.
4. ☐ Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 33-35,37-53,56 and 62.Claim(s) withdrawn from consideration: 36 54 55 57-61.

8. ☐ The proposed drawing correction filed on ____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.
10. ☐ Other: ____

Jeffrey C. Mullis
J Mullis
Art Unit: 1711

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ATTACHMENT TO ADVISORY ACTION

Applicants' amendment would require further consideration and/or search since the limitation that applicants' block copolymer is an ABA block copolymer or a multi-block copolymer was not previously present.

With regard to Matyjaszewski et al., applicants argue in the second to last paragraph on page 2 of their remarks that Matyjaszewski et al. do not disclose a process that comprises adding an alkenyl containing polymer I to a living radical polymerization system or living cationic polymerization system but that "Matyjaszewski merely suggests a process for producing a hyperbranch polymer . . . comprising adding an alkenyl-containing polymer to a living radical polymerization" (the last complete paragraph on page 2). Applicants also argue that patentees' process for producing a diblock, triblock or multi-block copolymer in schemes 3 and 4 do not require the addition of an alkenyl containing polymer to a living radical polymerization. However as set out in the final Office action, scheme 5 shows the presence of an alkenyl group. It appears to the Examiner that applicants are arguing that the alkenyl group containing species is not a diblock, triblock or multi-block copolymer. Firstly applicants' claims of record are not limited to diblock, triblock or multi-block copolymers since applicants' amendment has not been entered. But in any case, patentees refer to the material

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produced in scheme 5 as a "multiarmed star copolymer" at column 22 lines 50-51. Star copolymers are sometimes referred in the art to as star block copolymers and as is appropriate since each arm can be viewed as a block. Therefore there is no difference between Matyjaszewski and the instant claims since each and every element present in the instant claims is taught in Matyjaszewski.

With regard to applicants' remarks pertaining to obviousness, for the reasons set out above it is the position of the Examiner that only claim 36 is missing elements necessary for anticipation. With regard to claim 36, applicants argue that improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 U.S.C. § 103. However applicants have presented no comparative data showing unexpected results due to the presence of the elements present in claim 36.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

August 1, 2002

Jeffrey Mullis
Primary Examiner
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